

## REMARKS

Claims 1-30 and 33-38 are pending in the application. All claims stand rejected under 35 U.S.C. §112, first paragraph on the ground that the claim language “computer readable medium” is not defined in the specification. All claims stand rejected under 35 U.S.C. §101 for the same reason. The §112 and §101 rejections are intertwined in that if the disclosure is not enabling, the invention is inoperable.

Annex IV of the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (which have not been superseded, at least with regard to quoted passage) states that:

“When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).”

It would seem that the guidelines consider that the term “computer readable medium” is a well known term of art and need not be defined. See also, MPEP 2106.01. Moreover, the online encyclopedia Wikipedia makes many references to the phrase “computer readable medium”. Further, the instant application was filed with a CDROM Appendix containing the program code of the invention.

The Examiner states that “[a]n executable version of the claimed software being embodied on a computer readable medium” is considered critical to the invention being operative.” No support for this requirement is provided. The instant application was accompanied by a CDROM containing an embodiment of software according to the invention. In discussing this with the Examiner, the Examiner stated that the code provided on the disk was source code, not executable object code. This argument suggests that if I am claiming an apparatus, describing how to build it is not sufficient and that I must supply a working model of the apparatus to satisfy §§101 and 112. The source code is equivalent of detailed blueprints containing everything (except for building tools like screwdrivers, wrenches, etc. and materials such as nuts and bolts) a person of ordinary skill needs to make and use the invention.

The Examiner concludes the argument by stating:

“The court has said that there's a two-pronged test to determine whether a software or business method process patent is valid: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. In other words, pure software or business method patents that are neither tied to a specific machine nor change something into a different state are not patentable. *Ex parte Bilski*, Appeal No. 2007-1130 (Fed. Cir. October 30, 2008).”

This quote is not accurate. The “two-pronged test” was not formulated by the *Bilski* court; it was formulated by the Supreme Court in several cases. Further, it was never stated that the test was “to determine whether a software or business method process is valid”.

Nevertheless, the present invention clearly transforms a particular article<sup>1</sup> into a different state. The invention transforms product data gathered from product catalogs published on the world wide into a highly structured database which may also be published on the world wide web or published locally on a work station. Moreover, the invention, as illustrated, is tied to a particular machine, a PC or work station. It should also be noted that the *Bilski* decision never stated that so-called “Beauregard Claims” (computer readable medium claims) are no longer statutory.

The *Bilski* decision is not relevant to the claims presented in the October 1, 2008 amendment because the *Bilski* decision did not involve Beauregard Claims. It did not involve computer software claims. It involves a business method which was clearly an abstract idea or an algorithm that did not transform anything. The failure of the court in *Bilski* to mention Beauregard Claims cannot be interpreted to mean that these claims are not statutory. *See, In re Bilski*, 88 USPQ2d 1385 at 1395, n. 23 (Fed. Cir. 2008)<sup>2</sup> which is reproduced below:

“Therefore, although invited to do so by several amici, we decline to adopt a broad exclusion over software or any other such category of subject matter beyond the exclusion of claims drawn to fundamental principles set forth by the Supreme Court. *See, e.g., Br. of Amicus Curiae End Software Patents; Br. of Amicus Curiae Red Hat, Inc.* at 4-7. We also note that the process claim at issue in this appeal is not, in any event, a software claim. **Thus, the facts here would be largely**

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<sup>1</sup> It should be noted that definitions of “article” include “non-fictional prose forming an independent part of a publication”, “non-fictional prose” clearly reads on the type of data collected by the invention, and “publication” clearly reads on product catalogs published on the world wide web.

<sup>2</sup> This is the USPQ citation for the same case cited by the Examiner as *Ex parte Bilski*

**unhelpful in illuminating the distinctions between those software claims that are patent-eligible and those that are not.”** [Emphasis added.]

For the foregoing reasons and other reasons discussed below, it is requested that the §112 and §101 rejections be withdrawn.

In addition to the above, even if the §112 and §101 rejections were proper, the Examiner and his Supervisor were provided with a proposed amendment to the claims which is identical to the claims contained herein. On January 12, 2009, the Examiner telephoned the undersigned and stated that he and his Supervisor agreed that the proposed claims would overcome the §101 and §112 rejections.

It is requested that this amendment be entered without the requirement of filing an RCE. There was nothing in the last amendment that required these new grounds of rejection. The term “computer readable medium” was added to the claims in the first amendment filed dated October 2, 2007 with the understanding that this would render the claims allowable. A second (and final) Office Action issued December 20, 2007 and the Examiner did not object the phrase “computer readable medium”. The Applicant responded the second Office Action with an amendment dated March 20, 2008. A third Office Action issued on June 6, 2008 by the Examiner’s Supervisor. The third action still did not object to the phrase “computer readable medium”. The Applicant responded to the third Action with an amendment dated October 1, 2008. Prior to filing the October 1, 2008 amendment, a proposed amendment was sent to the Examiner by email. The Examiner presented the amendment to his SPE for review and the SPE presented it to

their “101 expert”. As stated in the Examiner’s emails of September 5 and September 10, the proposed amendment overcomes all of the §101 rejections. The proposed amendment was incorporated in the amendment as filed October 1, 2008.

From the foregoing, it is clear that nothing in the Amendment dated October 1, 2008 necessitated the new ground of rejection. This “new ground of rejection” could have been entered in 2007. Given that the Applicant has attempted to work with the Examiner and his Supervisor, it would be manifestly unfair at this point (more than five years after filing) to require that Applicant to file another RCE. Moreover, this Amendment does not raise any new issues which would need a new search. This amendment does not broaden the claims or present claims to subject matter not previously searched. If anything, this amendment eliminates issues already raised.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

/Thomas A Gallagher/

Thomas A. Gallagher  
Reg. No. 31358  
Attorney for Applicant(s)

107 Barclay Drive  
Stamford, CT 06903  
(203) 329-9898

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